

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion, is respectfully requested.

Claims 1 and 3-33 are pending. Claims 5-32 were withdrawn by the outstanding Office Action. In the present Amendment, Claims 1 4, 5, 7, and 23 are currently amended, Claim 2 is canceled without prejudice or disclaimer, and new Claim 33 is added. Support for the present Amendment can be found in the original specification, for example, at page 14, line 12 to page 15, line 17 and in Figures 1A, 2, 3A, 3B, 3C, and 4A. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. §102(b) as anticipated by Teratani et al. (Japanese Patent Publication No. 10-192036, hereinafter “Teratani”); Claims 2 and 4 were rejected under 35 U.S.C. §103(a) as unpatentable over Teratani in view of Riche (GB 921911); Claim 3 was rejected under 35 U.S.C. §103(a) as unpatentable over Teratani in view of De Benedictis (U.S. Patent 6,647,989); and it was noted that should Claims 1-3 be found allowable, Claims 1-3 will be objected to on the grounds of double patenting.

Initially, Applicants would like to thank Examiner Doan for the courtesies extended to Applicants’ representative during the interview held on November 5, 2008. During the interview, Applicants’ representative discussed proposed claim amendments in view of the cited references, and Examiner Doan made suggestions regarding these proposed amendments. In view of Examiner Doan’s suggestions, the present amendment is hereby submitted for formal consideration.

The specification is hereby amended to correct some minor informalities. It is respectfully submitted that no new matter is added.

Turning now to the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a), Applicants respectfully request reconsideration of these rejections and traverse these rejections, as discussed below.

Amended Claim 1 recites:

A hair inserter for inserting a hair bundle into a hair holder comprising a flat tube made of a sheet in such a design that the hair bundle can be inserted from an opening at one end of the tube toward an opening at an other end of the tube, the hair insert comprising:

a long main body having, at one end portion thereof, a hair catching part including a plurality of teeth to catch the hair bundle, and the long main body is configured to be smoothly inserted with a hair bundle caught on the hair catching part thereof into the tube from the opening at the one end toward the opening at the other end; and

a space forming member, slidably coupled with the long main body, that slides from a first position below the hair catching part to a second position covering the plurality of teeth to hold the hair bundle around the teeth.

Accordingly, the hair inserter recited in amended Claim 1 includes a space forming member that is slidably coupled with the long main body of the hair inserter. The space forming member slides from a first position below the hair catching part to a second position covering the plurality of teeth to hold the hair bundle around the teeth. Figures 3A-3C of the present application show an exemplary embodiment of the space forming member sliding to a position covering the teeth and thereby holding the hair bundle around the teeth. It is respectfully submitted that the cited references do not disclose or suggest every feature recited in amended Claim 1.

Teratani describes a hair winding tool and a hair winding method using the tool. However, as conceded on page 3 of the Office Action, Teratani does not disclose or suggest a sliding member. Instead, the Office Action relies on Riche to cure this deficiency of Teratani.

Riche describes an implement for curling hair including a slot 5 positioned at one end of the implement such that the tip of the hair can be passed through the slot.¹ Further, Riche describes a slider 6 that can be mounted on the body 4 of the implement such that an end of the slider 6 can grip the hair firmly on an end of the implement.²

However, it is respectfully submitted that Riche does not disclose or suggest “a space forming member, slidably coupled with the long main body, that slides from a first position below the hair catching part to a second position covering the plurality of teeth to hold the hair bundle around the teeth,” as recited in amended Claim 1.

Instead, as can be seen from Figures 4 and 5 of Riche, and as discussed during the interview, when hair is inserted into the slot 5 of the implement described in Riche, and the slider 6 is slid towards the hair, the slider could not travel past an end portion of the teeth, especially with hair positioned therebetween. Further, the cylindrical tab of the slider 6 passing through the groove of the body 4 would prevent the slider 6 from covering the teeth. Thus, the slider 6 could only hold the hair against an end of the teeth, and could not cover the teeth to hold the hair around teeth. Accordingly, the slider 6 described in Riche is not the claimed space forming member.

Therefore, it is respectfully submitted that the combination of Teratani and Riche does not disclose or suggest every feature recited in amended Claim 1. Further, it is respectfully submitted that De Benedictis does not cure the above-noted deficiencies of Teratani and Riche. Accordingly, it is respectfully submitted that Claim 1 patentably defines over the cited references. Thus, it is respectfully requested that the rejections of Claims 1, and Claims 3 and 4 which depend thereon, be withdrawn.

New Claim 33 is added by the present amendment. New Claim 33 is readable on the elected species directed to Figures 1(a)-4(c). Support for new Claim 33 can be found in

¹ See Riche, at page 2, column 1, lines 29-32 and in Figure 1.

² See Riche, at page 2, column 1, lines 32-36 and in Figures 4 and 5.

original specification, for example, at page 15, lines 3-17 and in Figures 1A, 2, 3C, and 4A. Thus, it is respectfully submitted that no new matter is added. Further, it is noted that Claim 33 is dependent on Claim 1, and thus is believed to be patentable for at least the reasons discussed above with respect to Claim 1.

Additionally, Claim 33 recites, in part, “in the second position, the space forming member is fixed in place by the upper stopper to completely cover the plurality of teeth to lock the hair bundle around the teeth.” In view of the above discussion of the cited references with respect to Claim 1, it is respectfully submitted that the references do not disclose or suggest the space forming member recited in Claim 33. Thus, it is respectfully submitted that Claim 33 further patentably defines over the cited references.

In response to the notice regarding the possibility of a double patenting rejection, as discussed above, it is noted that Claim 1 is hereby amended to recite a space forming member. Accordingly, it is respectfully submitted that none of the references listed by Examiner Doan as the possible basis for a double patenting rejection (U.S. Patent No. 7,305,995, 10/560,044, and 10/562,977) disclose or suggest the claimed space forming member. Accordingly, it is respectfully requested that the notice regarding the possible double patenting rejection be withdrawn.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A notice of allowance is earnestly solicited.

Respectfully submitted,

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